

Atty. Dkt. No. 035451-0187 (3735.Palm)

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 17, 28, and 38 are currently being amended.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each claim.

After amending the claims as set forth above, claims 17-32 and 35-45 are now pending in this application.

**Claim Rejections – 35 U.S.C. § 103(a)**

In section 2 of the Office Action, claims 17-19, 22, 24, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anzai et al. (U.S. Patent No. 6,259,597) in view of Moon (U.S. Patent No. 6,567,137). With regard to claim 17, Applicants respectfully submit that the cited combination of references fails to disclose all of the elements of claim 17 as combined therein. Specifically, claim 17 has been amended to recite “a lighting system coupled to the frame and configured to illuminate a display which is separate from the cover when the cover is positioned to overlay the display.” The cited combination of Anzai et al. in view of Moon does not teach, disclose, or suggest “a lighting system coupled to the frame and configured to illuminate a display which is separate from the cover when the cover is positioned to overlay the display” as included in the combination of elements of claim 17.

The Office Action correctly acknowledges that Anzai et al. “is silent as to how the display is illuminated” in section 3. The Office Action further states that Moon “discloses an invention in which a cover comprises a lighting system” and that “the lighting system illuminates a display when the cover panel is positioned proximate to the display.” Moon, however, discloses that “the auxiliary light source 60 is turned ‘on’ when the auxiliary light source is

Atty. Dkt. No. 035451-0187 (3735.Palm)

opened from the main body 58," and "turned 'off' when the auxiliary light source is snapped and folded against the main body." See col. 5, lines 35-39 and FIG. 6 (emphasis added). Moon further discloses that the "open position of the auxiliary light source is beyond the viewing range of an observer," and that the "auxiliary light source can radiate light ... without impinging the viewing range of the observer." See col. 5, lines 42-60. Thus, neither Moon nor the cited combination of Anzai et al. in view of Moon teaches, discloses, or suggests "a lighting system coupled to the frame and configured to illuminate a display which is separate from the cover when the cover is positioned to overlay the display." and particularly not as part of a "cover for a portable electronic device" when combined with the other elements of claim 17. Accordingly, Applicants request that the rejection of claim 17 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 18, 19, 22, 24, and 25 depend from claim 17 and are thus patentable over the cited combination of references for at least the same reasons as claim 17, and Applicants further request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well.

In section 9 of the Office Action, claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Anzai et al. in view of Moon, and further in view of Wilk (U.S. Patent No. 6,643,124). Claim 20 depends from claim 17. As explained above, the combination of Anzai et al. in view of Moon does not teach, disclose, or suggest the subject matter of claim 17. As to Wilk, it fails to disclose any of the elements of claim 17 mentioned above that are lacking in the cited combination of Anzai et al. in view of Moon. Because the cited combination of Anzai et al. in view of Moon, and further in view of Wilk fails to disclose all of the elements of claim 17 as combined therein, and because claim 20 depends from claim 17, claim 20 is patentable over the cited combination of references for at least the same reasons as claim 17. Accordingly, Applicants request that the rejection of claim 20 under 35 U.S.C. § 103(a) be withdrawn.

In Section 11 of the Office Action, claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Anzai et al. in view of Moon, and further in view of Wilk, and further in view of Branson (U.S. Published Patent Application No. 2003/0071832). Claim 21 depends from claim 20. As explained above, the combination of Anzai et al. in view of Moon and further in view of Wilk does not teach, disclose, or suggest the subject matter of claim 20. As to Branson,

Atty. Dkt. No. 035451-0187 (3735.Palm)

it fails to disclose any of the elements of claim 20 mentioned above that are lacking in the cited combination of Anzai et al. in view of Moon, and further in view of Wilk. Because the cited combination of Anzai et al. in view of Moon, and further in view of Wilk, and further in view of Branson fails to disclose all of the elements of claim 20 as combined therein, and because claim 21 depends from claim 20, claim 21 is patentable over the cited combination of references for at least the same reasons as claim 20. Accordingly, Applicants request that the rejection of claim 21 under 35 U.S.C. § 103(a) be withdrawn.

In Section 13 of the Office Action, claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Anzai et al. in view of Moon, and further in view of Agnew (U.S. Published Patent Application No. 2002/0084992). Claim 23 depends from claim 22. As explained above, the combination of Anzai et al. in view of Moon does not teach, disclose, or suggest the subject matter of claim 22. As to Agnew, it fails to disclose any of the elements of claim 22 mentioned above that are lacking in the cited combination of Anzai et al. in view of Moon. Because the cited combination of Anzai et al. in view of Moon, and further in view of Agnew fails to disclose all of the elements of claim 22 as combined therein, and because claim 23 depends from claim 22, claim 23 is patentable over the cited combination of references for at least the same reasons as claim 22. Accordingly, Applicants request that the rejection of claim 23 under 35 U.S.C. § 103(a) be withdrawn.

In Section 15 of the Office Action, claims 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anzai et al. in view of Moon, and further in view of Aufderheide (U.S. Patent No. 6,555,235). Claims 26 and 27 depend from claim 25. As explained above, the combination of Anzai et al. in view of Moon does not teach, disclose, or suggest the subject matter of claim 25. As to Aufderheide, it fails to disclose any of the elements of claim 25 mentioned above that are lacking in the cited combination of Anzai et al. in view of Moon. Because the cited combination of Anzai et al. in view of Moon, and further in view of Aufderheide fails to disclose all of the elements of claim 25 as combined therein, and because claims 26 and 27 depend from claim 25, claims 26 and 27 are patentable over the cited

Atty. Dkt. No. 035451-0187 (3735.Palm)

combination of references for at least the same reasons as claim 17. Accordingly, Applicants request that the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) be withdrawn.

In section 18 of the Office Action, claims 28, 29, 31, 32, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moon in view of Anzai et al., and further in view of Agnew. With regard to claim 28, Applicants respectfully submit that the cited combination of references fails to disclose all of the elements of claim 28 as combined therein. Specifically, claim 28 has been amended to recite that "the light guide is configured to direct light toward at least a portion of the display when the cover panel is positioned to overlay the display." The cited combination of Moon in view of Anzai et al., and further in view of Agnew does not teach, disclose, or suggest that "the light guide is configured to direct light toward at least a portion of the display when the cover panel is positioned to overlay the display" as included in the combination of elements of claim 28.

The Office Action states that Moon discloses "a lighting assembly coupled to the frame," and that "the light guide is configured to direct light toward at least a portion of the display when the cover panel is positioned over the display." Moon, however, discloses only that "the auxiliary light source 60 is turned 'on' when the auxiliary light source is opened from the main body 58," and "turned 'off' when the auxiliary light source is snapped and folded against the main body." See col. 5, lines 35-39 and FIG. 6 (emphasis added). Moon further discloses that the "open position of the auxiliary light source is beyond the viewing range of an observer," and that the "auxiliary light source can radiate light ... without impinging the viewing range of the observer." See col. 5, lines 42-60. Thus, Moon does not teach, disclose, or suggest that "the light guide is configured to direct light toward at least a portion of the display when the cover panel is positioned to overlay the display," and particularly not as part of a "portable electronic device" when combined with the other elements of claim 28.

As to Anzai et al. and Agnew, they fail to disclose any of the elements of claim 28 mentioned above that are lacking in Moon. Thus, the cited combination of references fails to disclose all of the elements of claim 28 as combined therein. Accordingly, Applicants request

Atty. Dkt. No. 035451-0187 (3735.Palm)

that the rejection of claim 28 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 29, 31, 32, and 35 depend from claim 28 and are thus patentable over the cited combination of references for at least the same reasons as claim 28, and Applicants further request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well.

In section 24 of the Office Action, claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Moon in view of Anzai et al., and further in view of Agnew, and further in view of Branson. Claim 30 depends from claim 28. As explained above, the combination of Moon in view of Anzai et al., and further in view of Agnew does not teach, disclose, or suggest the subject matter of claim 28. As to Branson, it fails to disclose any of the elements of claim 28 mentioned above that are lacking in the cited combination of Moon in view of Anzai et al., and further in view of Agnew. Because the cited combination of Moon in view of Anzai et al., and further in view of Agnew, and further in view of Branson fails to disclose all of the elements of claim 28 as combined therein, and because claim 30 depends from claim 28, claim 30 is patentable over the cited combination of references for at least the same reasons as claim 28. Accordingly, Applicants request that the rejection of claim 30 under 35 U.S.C. § 103(a) be withdrawn.

In section 26 of the Office Action, claims 36 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moon in view of Anzai et al., and further in view of Agnew, and further in view of Aufderheide. Claims 36 and 37 depend from claim 28. As explained above, the combination of Moon in view of Anzai et al., and further in view of Agnew does not teach, disclose, or suggest the subject matter of claim 28. As to Aufderheide, it fails to disclose any of the elements of claim 28 mentioned above that are lacking in the cited combination of Moon in view of Anzai et al., and further in view of Agnew. Because the cited combination of Moon in view of Anzai et al., and further in view of Agnew, and further in view of Aufderheide fails to disclose all of the elements of claim 28 as combined therein, and because claims 36 and 37 depend from claim 28, claims 36 and 37 are patentable over the cited combination of references for at least the same reasons as claim 28. Accordingly, Applicants request that the rejection of claims 36 and 37 under 35 U.S.C. § 103(a) be withdrawn.

Atty. Dkt. No. 035451-0187 (3735.Palm)

In section 29 of the Office Action, claims 38 and 42-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moon in view of Anzai et al. With regard to claim 38, Applicants respectfully submit that the cited combination of references fails to disclose all of the steps of claim 38 as combined therein. Specifically, claim 28 has been amended to recite "positioning a cover to overlay at least a portion of a display attached to a computing device, the cover comprising a touch panel and a lighting assembly," and "illuminating at least a portion of the display." The cited combination of Moon in view of Anzai et al. does not teach, disclose, or suggest "positioning a cover to overlay at least a portion of a display attached to a computing device, the cover comprising a touch panel and a lighting assembly," and "illuminating at least a portion of the display" as included in the combination of steps of claim 38.

The Office Action states that Moon discloses "positioning a cover adjacent to at least a portion of a display attached to a computing device, the cover lighting the assembly" and "illuminating at least a portion of the display." Moon, however, discloses only that "the auxiliary light source 60 is turned 'on' when the auxiliary light source is opened from the main body 58," and "turned 'off' when the auxiliary light source is snapped and folded against the main body." See col. 5, lines 35-39 and FIG. 6 (emphasis added). Moon further discloses that the "open position of the auxiliary light source is beyond the viewing range of an observer," and that the "auxiliary light source can radiate light ... without impinging the viewing range of the observer." See col. 5, lines 42-60. Thus, Moon does not teach, disclose, or suggest "positioning a cover to overlay at least a portion of a display attached to a computing device" and "illuminating at least a portion of the display," and particularly not as part of a "method for using a portable electronic device" when combined with the other steps of claim 38.

As to Anzai et al., it fails to disclose any of the elements of claim 38 mentioned above that are lacking in Moon. Thus, the cited combination of references fails to disclose all of the elements of claim 38 as combined therein. Accordingly, Applicants request that the rejection of claim 38 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 42-45 depend from claim 38 and are thus patentable over the cited combination of references for at least the same reasons

Atty. Dkt. No. 035451-0187 (3735.Palm)

as claim 38, and Applicants further request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well.

In section 35 of the Office Action, claim 39 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Moon in view of Anzai et al., and further in view of Wilk. Claim 39 depends from claim 38. As explained above, the combination of Moon in view of Anzai et al. does not teach, disclose, or suggest the subject matter of claim 38. As to Wilk, it fails to disclose any of the elements of claim 38 mentioned above that are lacking in the cited combination of Moon in view of Anzai et al. Because the cited combination of Moon in view of Anzai et al., and further in view of Wilk fails to disclose all of the elements of claim 38 as combined therein, and because claim 39 depends from claim 38, claim 39 is patentable over the cited combination of references for at least the same reasons as claim 38. Accordingly, Applicants request that the rejection of claim 39 under 35 U.S.C. § 103(a) be withdrawn.

In section 37 of the Office Action, claims 40 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moon in view of Anzai et al., and further in view of Wilk, and further in view of Branson. Claims 40 and 41 depend from claim 39. As explained above, the combination of Moon in view of Anzai et al., and further in view of Wilk does not teach, disclose, or suggest the subject matter of claim 39. As to Branson, it fails to disclose any of the elements of claim 39 mentioned above that are lacking in the cited combination of Moon in view of Anzai et al., and further in view of Wilk. Because the cited combination of Moon in view of Anzai et al., and further in view of Wilk, and further in view of Branson fails to disclose all of the elements of claim 39 as combined therein, and because claims 40 and 41 depend from claim 39, claims 40 and 41 are patentable over the cited combination of references for at least the same reasons as claim 39. Accordingly, Applicants request that the rejection of claims 40 and 41 under 35 U.S.C. § 103(a) be withdrawn.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

Atty. Dkt. No. 035451-0187 (3735.Palm)

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 7/15/2005By Chad E. Bement

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 297-5554  
Facsimile: (414) 297-4900

Chad E. Bement  
Attorney for Applicant  
Registration No. 54,991